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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,194	04/20/2001	Jeremy P. Clifford	05793.3026-00	1551
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER GREIMEL, JOCELYN	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			11/24/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/838,194

Applicant(s)

CLIFFORD ET AL.

Examiner

JOCELYN GREIMEL

Art Unit

3693

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09 October 2008 has been entered.

Status of Claims

Claims 1-30 are currently pending. Claims 1-9, 11-14, 17, 19, 21, 22, 25, and 28 are currently amended. Claims 1, 6, 11, 22, 25 and 28 are independent claims.

Response to Arguments

Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection, as detailed below.

Specifically, Applicant's argument that: *"Walker does not disclose Applicants' claim 1 recitations, including, inter alia, 'determining if the applicant accepts the at least one first financial account product,' and 'if the applicant accepts the at least one first financial account product, providing to the applicant a plurality of selectable options for further defining predetermined features of the at least one first recommended financial*

account product,' as recited in Applicants' amended independent claim 1." is discussed in detail in the following rejection. Additionally evaluated is the claim language of "selectable" and "unselectable" options.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1 and 22 recite a process comprising the steps of receiving, recommending, determining and customizing.

Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 23 states: "wherein the at least one unselectable option includes an option for the applicant to provide a value" and is unclear. If the option is unselectable – how does the applicant get to select the value? The terminology is unclear. Appropriate correction is required.

Examiner Note: Independent claims are examined together below, because they are not patentably distinct. If applicant expressly states on the record that two or more independent and distinct inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (US Patent No. 5,970,478) in view of Lent et al. (US Patent No. 6,324,524 B1, hereinafter Lent). In reference to claims 1, 6, 11, 22, 25 and 28, Walker discloses a method, system and computer readable medium for customizing a financial account product for an applicant comprising:

receiving account preference information from the applicant, the account preference information describing the applicant's preferences concerning various features of the financial account product;

recommending at least one first financial account product to the applicant based on the received account preference information;

receiving, from the applicant, one or more selections selected from the selectable options for the recommended at least one first financial account product; and

customizing the recommended at least one first financial account product based on the applicant's one or more selections (col. 2, line 56; col. 3, line 45 - col. 4, line 49; col. 5, line 39 - col. 6, line 55; col. 8, line 22 - col. 9, line 1 +).

Walker discloses the method above, but does not disclose:

determining if the applicant accepts the at least one first financial account product; if the applicant accepts the at least one first financial account product, providing, to the applicant, selectable options and at least one unselectable option for further defining predetermined features of the recommended at least one first financial account product.

However, Lent discloses:

determining if the applicant accepts the at least one first financial account product; if the applicant accepts the at least one first financial account product (*"the system notes the selected offer and balance transfer amount"*, (col. 14)), providing, to the applicant, selectable options (balance transfer from which account, col. 16) and at least one unselectable option (balance transfer amount, col. 16) for further defining predetermined features of the recommended at least one first financial account product.

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the method of Walker to include the selection process of Lent, as it would provide greater flexibility to the consumer, thereby increasing user-friendliness and revenue.

In reference to the dependent claims below, Walker discloses the method above, but does not disclose:

determining if the applicant accepts the at least one first financial account product; if the applicant accepts the at least one first financial account product, providing, to the applicant, selectable options and at least one unselectable option for further defining predetermined features of the recommended at least one first financial account product.

However, Lent discloses:

determining if the applicant accepts the at least one first financial account product; if the applicant accepts the at least one first financial account product (*"the system notes the selected offer and balance transfer amount"*, (col. 14), providing, to the applicant, selectable options (balance transfer from which account, col. 16) and at least one unselectable option (balance transfer amount, col. 16) for further defining predetermined features of the recommended at least one first financial account product.

It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to have modified the method of Walker to include the selection process of Lent, as it would provide greater flexibility to the consumer, thereby increasing user-friendliness and revenue.

1. In reference to claims 2, 7 and 12, Walker discloses a method, system and computer-readable medium, wherein the predetermined features of the at least one recommended financial account product selectable by the applicant comprise: at least one of the following: an annual percentage rate associated with the recommended financial account product, a fee structure associated with the recommended financial

account product, and a credit limit associated with the recommended financial account product (col. 5, line 39+).

2. In reference to claims 3, 8 and 13, Walker discloses a method, system and computer-readable medium, wherein providing to the applicant a plurality of selectable options, includes: permitting the applicant to prioritize each of the plurality of predetermined features; and customizing the recommended financial account product based on the applicant's prioritization of the predetermined features (col. 5 – col. 6).

3. In reference to claims 4, 9 and 14, Walker discloses a method, system and computer-readable medium, wherein providing to the applicant a plurality of selectable options includes: determining, for a first predetermined feature, the value of the selectable option for the first predetermined feature based on an option selected by the applicant for a second predetermined feature of the recommended financial account product (col. 5 - col. 8).

4. In reference to claims 5, 10 and 15, Walker discloses a method, wherein recommending the first financial account product includes: recommending the first financial account product to the applicant based on the received account preference information and based on information contained in an application submitted by the applicant (col. 5, line 39+).

5. In reference to claims 16-21, Walker discloses a method, system and computer readable medium for customizing a financial account product for an applicant comprising:

a. wherein the received account preference information from the applicant includes at least one of the following: information reflecting how often the applicant carries a balance for other types of financial account products, information regarding typical uses of current financial account products held by the applicant, and information reflecting one or more desired financial product features that most appeal to the applicant;

b. wherein the information regarding the one or more desired features that most appeal to the applicant includes at least one of the following: online shopping, warranty protection, replacement of less lost, stolen or damaged items, travel assistance services, ability to select a look of a new card associated with the financial account product, a payment due date, and additional authorized users associated with the financial account product (col. 5, line 39 – col. 6, line 55; col. 8, line 22 – col. 9, line 1+).

6. In reference to claims 23-24, 26-27 and 29-30, Walker discloses a method, system and computer readable medium for customizing a financial account product for an applicant comprising:

c. wherein the at least one unselectable option includes an option for the applicant to provide a value;

- d. wherein the value corresponds to at least one of the predetermined features (col. 5, line 39 – col. 6, line 55; col. 8, line 22 – col. 9, line 1+).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOCELYN GREIMEL whose telephone number is (571)272-3734. The examiner can normally be reached on Monday - Friday 8:30 AM - 4:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jocelyn Greimel
Examiner, Art Unit 3693
November 18, 2008

/Stefanos Karmis/
Primary Examiner, Art Unit 3693